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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,554	08/30/2001	Shannon M. Short	36968/259631 (BS01163)	9630

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MERCHANT & GOULD BELLSOUTH CORPORATION  
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MINNEAPOLIS, MN 55402

EXAMINER
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NGUYEN, NGA B

ART UNIT	PAPER NUMBER
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3692

MAIL DATE	DELIVERY MODE
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10/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/943,554

Applicant(s)

SHORT, SHANNON M.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>10/3/06</u> .                           |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

### **DETAILED ACTION**

1. This Office Action is the answer to the communication filed on August 14, 2006, which paper has been placed of record in the file.
2. Claims 1-20 and 22-26 are pending in this application.

### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 1-20 and 22-26 have been considered but are moot in view of the new grounds of rejection.
4. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-20 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anvekar et al (hereinafter Anvekar), U.S. Patent No. 6,684,072.

Regarding to claim 1, Anvekar discloses a method for prepaying roaming minutes, comprising the steps of:

crediting a user's account with prepaid roaming minutes (figures 5-6 and column 5, lines 5-35, e.g. account holder has prepaid roaming account includes the prepaid account balance);

subtracting roaming minutes from the user's account when calls are made outside the home calling area defined by the user's calling plan (column 6, lines 55-63, a successful roaming call is monitored in real-time, the prepaid account balance is decremented in real-time according to usage).

Anvekar does not disclose determining if the prepaid roaming minutes were purchased at a time greater than a predefined time before a call is made, if the prepaid roaming minutes were not purchased at a time greater than the predefined time, subtracting the roaming minutes from the user's account at a non-discounted rate when

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the call is made outside the home calling area defined by the user's calling plan.

However, the idea of determining if the service were purchased at a time greater than a predefined time before conducting the service, if the service were not purchased at a time greater than the predefined time, applying a non-discounted rate for the service, is well known in the art. For example, when a user purchases a dental plan, the user has to wait for a waiting period in order to receive a discount rate, e.g., if the user visits dentist for filling before the waiting period, the user may pay a full amount, otherwise, the user may pay only 20% of the amount. Moreover, subtracting the roaming minutes from the user's account at a non-discounted rate when the call is made outside the home calling area defined by the user's calling plan is well known in the art. For example, the telephone company charges the user at a non-discounted rate for the roaming minutes when the call is made outside the home calling area and the roaming minutes is not included in the user's calling plan. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Anveka's to adopt the well-known teaching above, for the purpose of encouraging the purchaser to buy more minutes from the provider before a determined time.

Regarding to claims 2-3, 16, and 21, Anveka does not disclose crediting prepaid roaming minutes at a discounted rate proportional to the time purchased. However, crediting prepaid roaming minutes at a discounted rate proportional to the time purchased is well known in the art. For example, the telephone service provider can offer to the purchaser a discounted rate based on the minutes purchased (volume discounted rate). Therefore, it would have been obvious to one with ordinary skill in the

art at the time the invention was made to modify Anveka's to adopt the feature above for the purpose of encouraging the purchaser to buy more minutes from the provider.

Regarding to claim 4, Anveka does not disclose crediting a user's account with prepaid roaming minutes periodically. However, crediting a user's account with prepaid roaming minutes periodically is well known in the art. For example, a telephone calling card can be recharged periodically. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Anveka's to adopt the feature above for the purpose of enabling the purchaser to take advantage of that to place calls.

Regarding to claim 5, Anveka does not disclose receiving a purchase order for roaming minutes from a user. However, receiving a purchase order for roaming minutes from a user is well known in the art. For example, a purchaser can purchase a calling card, a calling plan from a telephone provider. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Anveka's to adopt the feature above for the purpose of enabling the purchaser to place roaming calls.

Regarding to claim 6, Anveka does not disclose receiving a code before dialing a roaming call to access the user's account. However, receiving a code before dialing a roaming call to access the user's account is well known in the art. For example, when a purchaser makes calls using a calling card, the purchaser usually dials 800 toll-free number and then requested to enter PIN recorded on the card. Therefore, it would have

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been obvious to one with ordinary skill in the art at the time the invention was made to modify Anveka's to adopt the feature above for the purpose of enhancing the security.

Regarding to claims 7-8, Anveka does not disclose deleting the roaming minutes after a predetermined time, wherein the predefined time is about six months. However, deleting the roaming minutes after a predetermined time, wherein the predefined time is about six months. For example, a prepaid telephone calling card is set for usage within a period of time, e.g. three months, six months, after that the card is expired. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Anveka's to adopt the feature above for the purpose of encourage the purchaser to make calls within a predefined time period.

Regarding to claim 9, Anvekar further discloses wherein said subtracting step further comprises the step of: subtracting roaming minutes from the user's account when calls are made outside the home calling area defined by the user's calling plan if the roaming minutes were credited to the user's account at least a pre- defined time before the time that the call was made (column 6, lines 55-63, a successful roaming call is monitored in real-time, the prepaid account balance is decremented in real-time according to usage) .

Regarding to claim 10, Anveka does not disclose wherein the pre-defined time credited to the user's account is about one month. However, it is well known in the art to set pre-defined time after minutes credited to the user's account. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was

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made to modify Anveka's to adopt the feature above for the purpose of ensuring the purchaser has sufficient credit to make a call.

Regarding to claims 11-12, Anveka does not disclose crediting a user's account with a block of prepaid roaming minutes, wherein the block of prepaid roaming minutes is in increments of at least about 10 minutes. However, crediting a user's account with a block of prepaid minutes is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Anveka's to adopt the feature above for the purpose of providing more easier in calculating purchased price.

Regarding to claim 13, Anvekar further discloses notifying the user when a call is roaming (column 6, lines 40-50).

Regarding to claim 14, Anvekar further discloses notifying the user of roaming minutes in the roaming minutes account (column 8, lines 15-25).

Regarding to claim 15, Anvekar discloses a system for prepaying roaming minutes, comprising: a computer, and a software program loaded onto said computer configured to credit a user's account with prepaid roaming minutes and subtract roaming minutes from the user's account when calls are made outside the home calling area defined by the user's calling plan (figure 4 and column 4, lines 38-60, the central prepaid accounts data center 400).

Anvekar does not disclose determining if the prepaid roaming minutes were purchased at a time greater than a predefined time before a call is made, if the prepaid roaming minutes were not purchased at a time greater than the predefined time,



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subtracting the roaming minutes from the user's account at a non-discounted rate when the call is made outside the home calling area defined by the user's calling plan.

However, the idea of determining if the service were purchased at a time greater than a predefined time before conducting the service, if the service were not purchased at a time greater than the predefined time, applying a non-discounted rate for the service, is well known in the art. For example, when a user purchases a dental plan, the user has to wait for a waiting period in order to receive a discount rate, e.g., if the user visits dentist for filling before the waiting period, the user may pay a full amount, otherwise, the user may pay only 20% of the amount. Moreover, subtracting the roaming minutes from the user's account at a non-discounted rate when the call is made outside the home calling area defined by the user's calling plan is well known in the art. For example, the telephone company charges the user at a non-discounted rate for the roaming minutes when the call is made outside the home calling area and the roaming minutes is not included in the user's calling plan. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Anveka's to adopt the well-known teaching above, for the purpose of encouraging the purchaser to buy more minutes from the provider before a determined time.

Regarding to claims 17 and 19, Anvekar further discloses wherein said computer network is configured to allow a user to access the user's account using voice mail (column 8, lines 15-25).

Regarding to claims 18 and 23, Anveka does not disclose wherein said software is further configured to protect the user account with a password. However, protecting

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the user account with a password is well known in the art. For example, the user requires to enter password before allow the user access to the user's account.

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Anveka's to adopt the feature above for the security purpose.

Regarding to claim 20, Anvekar discloses a system for prepaying roaming minutes, comprising: a telephone, and a software program loaded onto said telephone configured to credit a user's account with prepaid roaming minutes and subtract roaming minutes from the user's account when calls are made outside the home calling area defined by the user's calling plan (figure 1 and column 3, lines 60-62, a roaming wireless phone 190).

Regarding to claims 22 and 24, Anvekar further discloses a computer network in communication with said telephone and configured for allowing the user to access the account using voice mail (column 8, lines 15-25).

Regarding to claim 25, Anvekar discloses wherein said telephone is a wireless telephone (figure 1 and column 3, lines 60-62, a roaming wireless phone 190).

Regarding to claim 26, Anveka does not disclose wherein said telephone is a digital telephone. However, using digital telephone for making calls is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Anveka's to adopt the feature above for the purpose of providing more convenient to the use when using digital telephone in making calls.

**Conclusion**

7. Claims 1-20 and 22-26 are rejected.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).

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A handwritten signature in black ink, appearing to read 'Nga Nguyen', with a stylized, cursive script.

NGA NGUYEN  
PRIMARY EXAMINER

October 1, 2007